

# REMARKS

Claims 1 to 58 were pending in the application at the time of examination. Claims 1 to 58 stand rejected as obvious.

Claim 30 is objected to for informalities. Claim 30 has been amended as suggested by the Examiner. Applicant respectfully requests reconsideration and withdrawal of the objection to Claim 30.

Claims 1, 10, 19, 28 are amended for consistency. Each of these claims recited that the authenticated digital content request included one or more delivery parameters. Since the same authenticated digital content request is recited in each element of the claim, that request includes the recited features. Therefore, the amendment only makes explicit that which was implicit in the claims themselves.

Claims 1 to 4, 6 to 13, 15 to 22, 24 to 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0015703, hereinafter referred to as Madison, in view of U.S. Patent Application Publication No. 2004/0107167, hereinafter referred to as Maari.

Applicant respectfully traverses the obviousness rejection of Claims 1, 10, 19 and 28. The rejection still fails to treat the prior art references consistently, and so fails to consider the references as a whole. Moreover, the combination fails to satisfy the requirements of the MPEP. The MPEP requires that the references and the claims be considered as a whole. *"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention."* (Emphasis in original) MPEP § 2141.02 VI., 8<sup>th</sup> Ed., Rev. 6, pg. 2100-126, (Sept. 2007).

The rejection stated in part:

Madison teaches a method for digital content access control, comprising: sending, by an end- user device to a content provisioner, a digital content request comprising a request for digital content (paragraph [0040]);

Thus, paragraph [0040] of Madison is cited as teaching an end user device, a content provisioner, and sending a digital content request by the end-user device to the content provisioner. Paragraph [0040] of Madison stated:

[0040] The process of generating the ticket by the web server 106 will now be described in greater detail with reference to FIG. 4. As noted above, the ticket generation process is preferably performed by an authorization software plug-in residing at the web server 106. In the present embodiment, the process begins with the web server 106 receiving the stream request, including the stream ID, and the end user ID. Step 402. The web server 106 then proceeds to access the database 108 to retrieve the private key information associated with the requested stream ID. Step 406. Such private key information includes the universal security key and the security interval. In an alternate embodiment, each stream has its own security key and security interval stored as fields in the Streams Table 204, which the web server 106 retrieves based on the stream ID contained in the stream request.

This paragraph describes only generating a ticket by the web server and nothing about any sending by an end-user device. Accordingly, the web server is apparently being characterized as the content provisioner of the claim as a web server is not an end user device.

Next, the rejection stated in part:

receiving, from said content provisioner by said end-user device, an authenticated digital content request in response to said sending said digital content request (paragraph [0055]);

However, paragraph [0055] of Madison stated:

[0055] In determining whether to grant access, the streaming media server 104 first receives the stream request, including the stream ID, end user ID and ticket, from the media player residing on the end user's processor 102. Step 502. Once the stream request is received, the media server 104 generates the input string to the hash algorithm. In this regard, the media server 104 retrieves from local memory the private key information, namely the security key and security interval. Step 506. Preferably, the media server 104 stores the private key information in local memory, however, in alternate embodiments the media server 104 stores the information in an active directory tree accessed by, for example, Light-Weight Directory Access Protocol provided by the Microsoft Corporation, or in a remote database. In still another alternate embodiment, the media

server 104 retrieves the private key information by accessing the database 108 via a network connection, such as Local Area Network (LAN)

This paragraph describes only the streaming media server 104. Thus, with respect to first claim element, web server 106 of Madison was cited as the content provisioner, and with respect to the second claim element, media server 104 was cited as the content provisioner. Thus, the characterization of the content provisioner changes depending on the claim element. This is clear evidence that neither the claim element nor the reference was considered as a whole. This alone is sufficient to demonstrate that a prima facie obviousness rejection has not been made even if the combination of references is proper.

Moreover, the rejection has failed to cite any teaching in either of the references of "receiving, from said content provisioner by said end-user device, an authenticated digital content request" with "the one or more delivery parameters identifying a target device to receive digital content referenced by said authenticated digital content request."

When the references are considered as a whole the references teach away from this element. The rejection as noted above mischaracterizes the teachings of Madison. Madison taught that the web server returned "the ticket and the end user ID" to the end-user device. Madison, Paragraph [0067]. The end user ID identifies a particular the end-user, and not a device. See Paragraph [0027] of Madison. Thus, the web server, which was identified by the rejection as the content provision, does not return the authenticated digital content request as recited in these claims.

Moreover, the end-user device of Madison does not simply send the request received from the web server, but instead must build a link. Specifically, Paragraph [0037] of Madison illustrates a link that is built and then sent

by the end user device. This is fundamentally different from the process recited in these claims. Further, the link identifies the media to be streamed, provides a ticket and the end user ID. None of these are delivery parameters identifying a target device. Thus, Madison taken as a whole teaches that such delivery parameters are unnecessary and also teaches away from the send, receiving and sending processes as recited in these claims.

Nevertheless, the rejection modifies Madison by adding player 1 of Maari. However, again the rejection has failed to identify anything in a response from a content provisioner that includes the recited delivery parameters.

In Maari, the process is fundamentally different from that in either Madison or the claims. The player is registered with the administration center on purchase (Maari, Paragraph [0065]). Subsequently, when the user takes an action, the interaction is between user terminal 50 and player 1, e.g.,

[0072] The content manipulated at the administration center 211 is transmitted to the virtual store 230 as shown in (5) of FIG. 5 and further supplied from the virtual store 230 to the user terminal 50 of the user 200 as shown in (6) of FIG. 5. The desired content is supplied from the user terminal 50 to the player 1 to be stored therein.

This section teaches or suggests nothing about user terminal 50 using delivery parameters in sending the content to the player 1. Moreover, Maari taught that "sending, by said end-user device, said authenticated digital content request including one or more delivery parameters to a content repository" was unnecessary. Specifically,

[0131] The following describes a processing flow in the user terminal 50 for obtaining digital content with reference to FIG. 13.

[0132] As shown in FIG. 13, in step ST51, the user terminal 50 starts the software for obtaining digital content. When this software is started, the user terminal 50 accesses, in step S52, the administration center 211 having a registered address according to the software for obtaining digital content.

[0133] At this moment, the administration center 211 is displaying plural pieces of digital contents by use of the virtual store 230. In step ST53, the user selects a desired digital content through the user terminal 50 from among the digital contents displayed in the virtual store 230. To be more specific, the user terminal 50 sends content specification information for specifying a desired digital content from among those displayed in the virtual store 230 to the administration center 211. (Emphasis Added)

[0134] In step ST55, when the user terminal 50 receives the data returned from the administration center 211 according to the above-mentioned content specification information, namely the data composed of the encoded digital content and the content ID, the user terminal 50 temporarily stores the received data in an internal storage means such as hard disk or memory device in step ST56. (Emphasis Added)

[0135] Then, the user terminal 50 transfers the stored data (namely, the encoded digital content and the content ID) to the player 1 as shown in step ST42 of FIG. 12.

Thus, Maari expressly described what was sent to obtain the digital content and what was received. There is no suggestion of delivery parameters as recited in these claims. Thus, when the references are considered as a whole neither reference suggests nor discloses any need for such parameters. Accordingly, even if the player of Maari could be extracted and substituted into Madison, there is no teaching or suggestion of any need or use of delivery parameters.

Moreover, Maari taught that the player 1 was intimately involved in the processing of requests for digital content. See Figs. 11, 19 and 24. In contrast, in Madison, the processing is done on servers, and the end user device is simply provided the digital content from the servers. Accordingly, the addition of the player 1 of Maari requires inputs, interactions, and information that are not available on the end user device of Madison. Accordingly, to incorporate player 1 of Maari would change the principle of operation of Madison.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

MPEP §2143.01 VI., 8<sup>th</sup> Ed., Rev. 6, pg. 2100-141, (Sept. 2007). Thus, not only was the reference not considered as a whole, but also the modifications necessary to make the reference applicable to Applicant's claims change the principles of operation of Madison and so according to the MPEP a prima facie obviousness rejection has not been made.

Applicant respectfully notes that only one of these showings is needed to overcome the obviousness rejection. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 1, 10, 19 and 28.

Claims 2 to 4, 6 to 9, 11 to 13, 15 to 18, 20 to 22, 24 to 27 and 29 distinguish over the combination of references for at least the same reasons as the independent claim from which each depends. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 2 to 4, 6 to 9, 11 to 13, 15 to 18, 20 to 22, 24 to 27 and 29.

Claims 5, 14, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Madison in view of Maari and further in view U.S. Patent Application Publication No. 2002/0072413, hereinafter referred to as Arias.

Assuming the combination of three references is correct, the additional material relied upon from Arias fails to correct the defects of the combination of Madison and Maari, as noted above, for the independent claim from which each of Claims 5, 14, and 23 depends. Thus, each of Claims 5, 14, and 23 distinguishes over the combination of three references for at least the same reasons as the independent claim from which each depends. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 5, 14, and 23.

Claims 30 to 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Madison in view Maari and further in view U.S. Patent Application Publication No. 2003/0073440, hereinafter referred to as Mukerjee.

Assuming the combination of three references is correct, the additional material relied upon from Mukerjee fails to correct the defects of the combination of Madison and Maari, as noted above, for the independent claim from which each of Claims 30 to 34 depends. Thus, each of Claims 30 to 34 distinguishes over the combination of three references for at least the same reasons as the independent claim from which each depends. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 30 to 34.

Claims 35, 38, 41, 44, 47, 50 and 53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0015703, hereinafter referred to as Madison, in view of U.S. Patent Application Publication No. 2003/0140257, hereinafter referred to as Peterka, and further in view of U.S. Patent Application Publication No. 2004/0107167, hereinafter referred to as Maari.

While the standard for combination of references in a prima facie obviousness rejection has been broadened by *KSR International Co. v. Teleflex Inc.*, the MPEP includes specific criteria that must be met for a combination to establish a prima facie obviousness rejection. As demonstrated below, these requirements have not been met and so a prima facie obviousness rejection has not been made.

As noted above, the MPEP requires that the references and the claims be considered as a whole. *"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention."* (Emphasis in original) MPEP § 2141.02 VI., 8<sup>th</sup> Ed., Rev. 6, pg. 2100-126, (Sept. 2007).

Madison, taken as a whole, taught that the end user device receives a ticket and an end user ID, and then appends this information to a link, sends the link and accesses the request content when allowed. Madison expressly taught that various authentication, validation

processes were performed on servers removed from the end user device. The end user device of Madison was separate and distinct from the server devices of Madison.

Similarly, in Peterka, the information relied upon in the rejection in paragraphs [0040] to [0042] of Peterka is performed at a content provider site and a caching server.

There has been no showing that end-user device 102 of Madison would function as a caching server or a content provider. In fact, as previously noted Madison taught that the end-user device was separated and distinct from the server devices. Accordingly, Madison as one of skill in the art taught away from implementing server functionality on an end-user device. Peterka similarly taught such a distinction. Therefore, the proposed combination of Madison and Peterka requires changes to the principles of operation of both references by moving functionality performed on a server to a non-server device. As noted above, the MPEP directs that there is no basis for such a combination.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

MPEP §2143.01 VI., 8<sup>th</sup> Ed., Rev. 6, pg. 2100-141, (Sept. 2007).

Similarly, as noted above and incorporated herein by reference, the use of Maari in Madison also changes the principles of operation of Madison. The MPEP is unambiguous that "the teachings of the references are not sufficient to render the claims *prima facie* obvious." Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 35, 38, 41, 44, 47, 50 and 53.

Claims 36, 39, 42, 45, 48, 51, and 54 to 58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Madison in view Peterka, further in view of Maari and



still further in view U.S. Patent Application Publication No. 2003/0073440, hereinafter referred to as Mukerjee.

Assuming the combination of four references is correct, the additional material relied upon from Mukerjee fails to correct the defects of the combination of Madison Peterka and Maari, as noted above, for the independent claim from which each of Claims 36, 39, 42, 45, 48, 51, and 54 to 58 depends. Thus, each of Claims 36, 39, 42, 45, 48, 51, and 54 to 58 distinguishes over the combination of four references for at least the same reasons as the independent claim from which each depends. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 36, 39, 42, 45, 48, 51, and 54 to 58.

Claims 37, 40, 43, 46, 49 and 52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Madison in view of Peterka, further in view of Maari, and still further in view U.S. Patent Application Publication No. 2002/0072413, hereinafter referred to as Arias.

Assuming the combination of four references is correct, the additional material relied upon from Arias fails to correct the defects of the combination of Madison Peterka and Maari, as noted above, for the independent claim from which each of Claims 37, 40, 43, 46, 49 and 52 depends. Thus, each of Claims 37, 40, 43, 46, 49 and 52 distinguishes over the combination of four references for at least the same reasons as the independent claim from which each depends. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 37, 40, 43, 46, 49 and 52.

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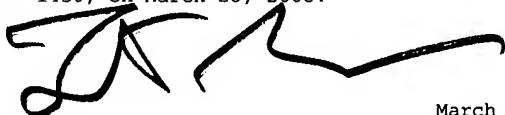
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Claims 1 to 58 remain in the application. Claims 1, 10, 19, 28, and 30 have been amended. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on March 28, 2008.



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March 28, 2008  
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